



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,216	12/12/2001	Minoru Yamada	01802/HG	8903
1933	7590	12/21/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			TUGBANG, ANTHONY D	
220 Fifth Avenue			ART UNIT	
16TH Floor			PAPER NUMBER	
NEW YORK, NY 10001-7708			3729	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/021,216

Applicant(s)

YAMADA, MINORU

Examiner

A. Dexter Tugbang

Art Unit

3729

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

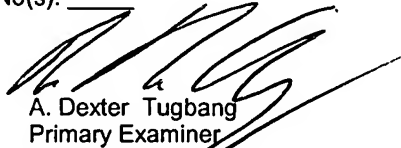
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Attachment, Paragraph 1.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1, 2, 8 and 9.
Claim(s) withdrawn from consideration: 3-7 and 10-13.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment, Paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☒ Other: As for the Election/Restriction, see Attachment Paragraph 2.


A. Dexter Tugbang
Primary Examiner
Art Unit: 3729

Art Unit: 3729

Attachment to Advisory Action

1. Amendment to Claim 9

The After Final amendment filed on December 2, 2005, has been entered and made of record. The rejection of Claim 9 under 112, 2nd paragraph (Final Rejection, dated October 3, 2005, paragraph 6) has been withdrawn in light of changes to Claim 9.

2. Election/Restriction

The applicant(s) urge that the Election of Species requirement be withdrawn with respect to Claims 10-13 as the applicant(s) believe that Claims 10-13 are directed to Species A along with Claims 1, 2, 8 and 9.

While the examiner very much appreciates the attached figures to illustrate their point in the differences of Species A, B and C, the examiner most respectfully disagrees that Claims 10-13 belong with Species A. First, in Species A as recited in Claims 1, 2, 8 and 9 and in the specification (at page 26), the process of plating requires no catalyst at all. Second, in Species B as recited in Claims 3 and 10-13, particularly Claims 3 and 10, and in the specification (page 36), a catalyst is required for the plating process. This is the basis for the examiner making the election of species requirement and why each Species as claimed (in claims 1, 3 and 10) is patentably distinct from one another. The examiner notes that in the attached Figures, Figure (1) representing Species A appears to be incorrect as it shows a catalyst and the specification (at page 26) and in Figure 1 discloses that plating can be performed with no such catalyst. Accordingly, the examiner maintains the election of species requirement and that Claims 10-13 continue to stand as being withdrawn by original presentation.

Art Unit: 3729

3. Prior Art

With respect to the merits of Temple'055, the applicant(s) argue that Temple'055 does not teach "plating a surface of a channel plate having a plurality of grooves for the ink channels" (lines 8-9 of Claim 1), because the channel plate of Temple'055 does not having any grooves when plating. The examiner notes that the claims do not recite any separate any active step as to *when* the claimed "grooves" are formed, i.e. that the grooves are formed prior to the step of plating. So it appears that the applicant(s) are arguing more specifically than that which is claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, in the attached Figures by the applicant(s), Figure (1) shows that plating occurs with the appearance of no such grooves in the channel plate, which would support the examiner's position as to how Claim 1 was interpreted.

In Temple'055, the grooves 29 are shown to be formed in Figure 3b. However, the examiner notes that although this may raise new issues requiring further consideration and search, if the claims were amended to include further limitations of an active step of --forming grooves in a channel plate-- before the step of "plating...", this would appear to avoid the reference to Temple'055.